

REMARKS

Reconsideration and allowance of the subject patent application are respectfully requested.

The specification has been amended to correct a minor informality. Entry of this amendment is respectfully requested.

In view of the election set forth in the paper filed on October 12, 2004, claims 33-42 have been canceled without prejudice or disclaimer. Applicants reserve the right to file divisional application(s) directed to the subject matter of the non-elected claims. Applicants respectfully that claim 1 is generic to other species identified in the 9/15/2004 office action. Upon allowance of such a generic claim, Applicants are entitled to consideration of claims to additional species that are written in dependent form or otherwise include all the limitations of an allowed generic claim. *See* 37 C.F.R. 1.141.

Claims 9 and 10 were rejected under 35 U.S.C. Section 112, second paragraph, as allegedly being indefinite. Claim 9 has been amended to address the antecedent basis issue identified in the office action and withdrawal of the Section 112, second paragraph, rejection of claims 9 and 10 is respectfully requested. Claims 9 and 10 are not otherwise rejected.

Claims 1, 3 and 16 were rejected under 35 U.S.C. Section 102(b) as allegedly being anticipated by Yasukawa (U.S. Patent No. 6,232,142). While not acquiescing in this rejection, claims 1 and 3 have been amended and claim 16 has been canceled without prejudice or disclaimer. As such, the discussion below makes reference to the amended claims.

Independent claim 1 calls for semiconductor device comprising a single-crystal silicon substrate that is bonded with an insulating substrate on a partial region of the insulating substrate. A surface of the single-crystal silicon substrate is substantially free of damage and has a substantially uniform thickness. In contrast, Yasukawa does not disclose a single-crystal silicon substrate formed only on a partial region of an insulating substrate. Instead, Yasukawa discloses a single-crystal silicon substrate formed over the entirety of an insulating supporting substrate 1. *See, e.g.,* Figure 1. Yasukawa does not disclose a semiconductor device as in claim 1 and thus Yasukawa cannot anticipate claim 1 or dependent claim 3. *See, e.g., Verdegaa Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) ("A claim is

anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.").

Claims 4 and 12-15 were rejected under 35 U.S.C. Section 103(a) as allegedly being unpatentable over Yasukawa. The purported obviousness of the features of claims 4 and 12-15 does not remedy the deficiency of Yasukawa in connection with claim 1, from which claims 4 and 12-15 depend. In addition, Applicants traverse the allegations in the office action as to the inherency of the features of claims 14 and 15. The identification of the same or similar materials in Yasukawa does not necessarily mean that these materials have the characteristics set forth in these claims. *See, e.g.*, MPEP Section 2112; *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.)

Claims 2 and 5 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over Yasukawa in view of Yudasaka (JP 6-11729). Yudasaka is cited in the office action as allegedly showing a single-crystal silicon film and a non-single crystal silicon film formed in different regions of an insulating substrate. Yudasaka does not remedy the deficiencies of Yasukawa with respect to claim 1, from which claims 2 and 5 depend. Consequently, the proposed combination of these documents, even if proper, would not have resulted in the subject matter of claims 2 and 5.

New claims 43-53 have been added. The subject matter of this new claim is fully supported by the original disclosure and no new matter is added. These new claims are readable on the elected species of Figures 1a-1h.

Claim 43 calls for a semiconductor structure comprising an insulating substrate having a surface on which a first SiO₂ film is formed, and a single-crystal silicon substrate bonded with the insulating substrate. The single-crystal silicon substrate includes a BOX layer, a hydrogen ion implantation section in which distribution of hydrogen ions peaks in the BOX layer, and a single-crystal silicon thin film formed on the BOX layer, wherein the single-crystal silicon substrate has a surface which is on a single-crystal silicon thin film side with respect to the BOX layer and on which a second SiO₂ film is formed. The surface of the insulating substrate, where the first SiO₂ film is formed, is bonded with the surface of the single-crystal silicon substrate,

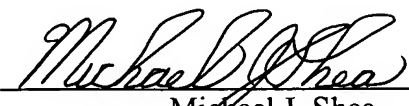
where the second SiO₂ film is formed. No such structure is shown in the applied documents. Claims 44-50 depend from claim 43.

Claim 51 is directed to a semiconductor device comprising an insulating substrate having a surface on which a first SiO₂ film is formed, and a single-crystal silicon substrate bonded to the insulating substrate, the single-crystal silicon substrate having a substantially uniform thickness and a substantially damage-free surface. The single-crystal silicon substrate includes a single-crystal silicon thin film and a second SiO₂ film formed on the surface of the single-crystal silicon substrate bonded with the insulating substrate and the surface of the insulating substrate on which the first SiO₂ film is formed is bonded with the surface of the single-crystal silicon substrate on which the second SiO₂ film is formed. The single-crystal silicon substrate is disposed on only part of the surface of the single-crystal silicon substrate on which the second SiO₂ film is formed. No such structure is shown in the applied documents. For example, Yasukawa discloses a single-crystal silicon substrate formed over the entirety of an insulating supporting substrate. Claims 52 and 53 depend from claim 51.

The pending claims are believed to be allowable and favorable office action is respectfully requested.

Respectfully submitted,

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